

REMARKS

This is in response to the Office Action mailed September 1, 2004, in which the Examiner allowed claims 15-18, rejected claims 1, 9-14, 23, 26-29, 32 and 33, and objected to claims 3, 24 and 25. Applicants have amended claims 9 and 23. Reconsideration of the application, as amended, is respectfully requested.

Request for Consideration of All Submitted References

Applicants request that the Examiner acknowledge that the references cited in the Information Disclosure Statement filed April 27, 2004 have been considered. A copy of the Information Disclosure Statement is enclosed herein along with a copy of the return postcard indicating receipt by the United States Patent and Trademark Office. Applicants request consideration and entry of the cited references.

Restriction Requirement

The Examiner made the restriction of the application to the invention of Group I final based on a finding that claim 15 recites a polishing process that would not be required to form the product claims (claims 19-22). However, as stated in Applicants' previous response, the method of claim 1 does not provide such a limitation. As a result, the Examiner has failed to identify how the product claims can be formed from a materially different process than that described in independent claim 1. Accordingly, although the Examiner may have expressed reasonable grounds for the restriction between claim 15 and the product claims, those same grounds do not apply to independent claim 1. Therefore, Applicants request that the restriction be withdrawn.

Also in the Office Action, the Examiner withdrew claims 34 and 35 from further consideration, but provided no response to Applicants' request for reconsideration and arguments submitted in the response filed June 28, 2004. In that response, Applicants expressed disagreement with the Examiner's assessment that the method of Invention II (claims 34 and 35) "has separate utility such as a lift-off mask", since Applicants are unaware of any such separate utility. Additionally, Applicants submitted that the Examiner has failed to provide any support for the finding of separate utility by way of an example. Applicants respectfully request that the Examiner reconsider the restriction and address the presented argument.

Allowable Subject Matter

Applicants acknowledge the Examiner's finding that claim 15 is allowable and that claims 16-18 depending therefrom are rejoined and are also in condition for allowance.

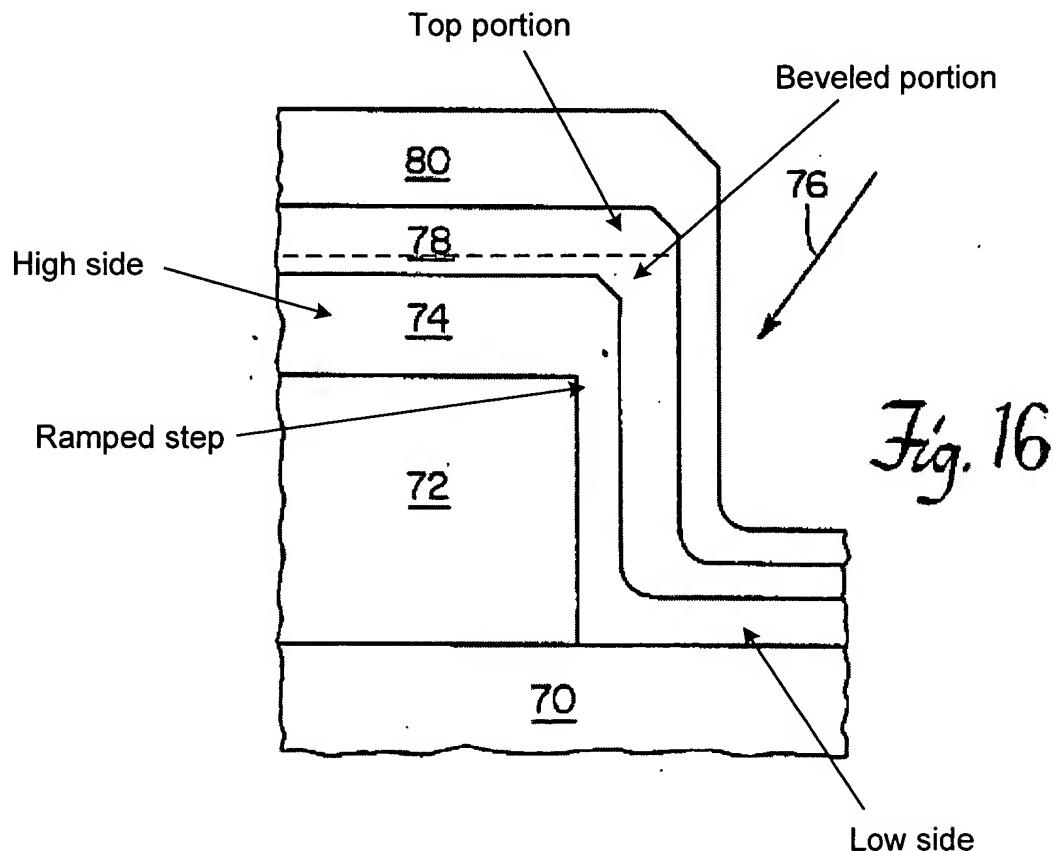
Objection to the Specification

In Section 7 of the Office Action, the Examiner objected to the title as being non-descriptive of the invention and suggested a replacement. Applicants have amended the title as suggested. However, should the Examiner find Applicants' arguments provided above regarding the restriction to be persuasive, Applicants would submit that the amended title be replaced with the original title.

Claim Rejections - 35 U.S.C. §102

In Section 9 of the Office Action, the Examiner rejected claims 1, 9-12, 23, 26-29, 32 and 33 under 35 U.S.C. §102(b) as being anticipated by Mallary et al. (U.S. Patent No. 4,912,584). Applicants respectfully disagree with the Examiner's rejections for the reasons set forth below.

On October 25, 2004, Applicants' representative, Brian D. Kaul, had a telephone interview with Examiner Paul Kim. During the interview, the Examiner provided clarification as to the portions of the cited "writing pole portion (78)" in FIG. 16 of Mallary et al. that correspond to the "beveled portion" and the "top portion" described in claims 1, 26 and 28. The location of those elements, as indicated by the Examiner, are provided below.



Although the Examiner did not specifically address claim 1 in the rejections based on Mallary et al., Applicants assume that the steps described in the second paragraph of Section 9 were intended to be used to reject the claim. Applicants disagree with the Examiner's finding that FIG. 17 in column 4, lines 29-68 of Mallary et al. discloses "defining a pole tip of the writing pole portion having an air bearing surface and a thickness substantially corresponding to a thickness of the top portion", as described in claim 1. In particular, the "beveled" and "top" portions of the writing pole portion 78 (FIG. 16) cited by the Examiner are completely eliminated in FIG. 17. As a result, Mallary et al. fail to disclose "defining a pole tip of the writing pole portion", which as stated in step (b) of claim 1 requires a top portion and a beveled portion. Furthermore, there is no disclosure in Mallary et al. relating to defining or forming "a pole tip of the writing pole portion having an air bearing surface", as described in claim 1.

Therefore, Applicants submit that claim 1 is allowable even in view of Mallary et al., and request that the rejection be withdrawn. Additionally, Applicants submit that all claims depending from claim 1 are allowable as being dependent from allowable base claim 1, and request that the rejections be withdrawn.

Applicants have amended claim 23 to more clearly describe the ramped step as "having a top surface extending from a top surface of the high side to a top surface of the low side, wherein the top surface of the ramp is non-perpendicular to the top surfaces of the high and low sides". Such a ramped step is not disclosed or suggested by the cited ramped step 74 of Mallary et al.

Therefore, Applicants believe that claim 23 is allowable in view of Mallary et al., and request that the

rejections be withdrawn. Additionally, Applicants submit that all claims depending from claim 23 are allowable as being dependent from an allowable base claim, and request that the rejections be withdrawn.

In Section 10 of the Office Action, the Examiner rejected claims 1 and 14 under 35 U.S.C. §102(b) as being anticipated by Das (U.S. Patent No. 5,075,956). Applicants respectfully disagree with the Examiner's assessment of Das.

In particular, Applicants disagree with the Examiner's finding that element 76 of FIG. 24a of Das discloses the step of "forming a writing pole portion on the ramped step having a top portion overlaying a beveled portion", as described in claim 1. As discussed in the present application on page 9, line 10 through page 11, line 13, the claimed writing pole portion is used to form a beveled writing pole that is used to write data to a recording medium in accordance with perpendicular data writing techniques.

Rather than being a "writing pole portion", the element 76 of Das forms a "lower section 34b of shield 34." [col. 7, line 67 - col. 8, line 1] Nowhere in Das is there any disclosure of layer 76 being a component of a pole that performs writing operations, something only the probe 61 of Das operates to do. [col. 7, lines 20-32] As understood by those skilled in the art, magnetic shields, such as the lower shield 34b (layer 76) of Das and return poles 188 of the present invention, operate to form a return path through which magnetic flux is conducted, but in a manner that does not affect the stored information on the media. [see col. 6, lines 45-48 and col. 9, lines 31-33 of Das]

Therefore, Applicants submit that Das fails to anticipate independent claim 1, and request that the rejection be withdrawn. Additionally, Applicants submit that claim 14 is

allowable as being dependent from allowable base claim 1, and requests that the rejection be withdrawn.

Claim Rejections - 35 U.S.C. §103

In Section 12 of the Office Action, the Examiner rejected claim 13 under 35 U.S.C. §102(b) as being unpatentable over Mallary et al. Applicants respectfully believe that the rejection can be withdrawn for at least the reasons set forth above with regard to claim 1, from which claim 13 depends.

Allowable Subject Matter

In Section 13 of the Office Action, the Examiner objected to claims 3, 24 and 25, but indicated that they would be allowable if rewritten in independent form. However, in light of the discussion above, Applicants submit that claims 3, 24 and 25 are presently in condition for allowance as being dependent from allowable base claims, and request that the objections be withdrawn.

In Section 14 of the Office Action, the Examiner indicated at claims 15-18 were allowed.

Conclusion

In view of the above comments and remarks, Applicants submit that the present application is in condition for allowance. Reconsideration and favorable action is respectfully requested.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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BDK/djb

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Receipt is hereby acknowledged by the Assistant Commissioner of Patents and Trademarks of the following items in the matter of:

Applicant : Martin L. Plumer et al.  
Serial No./Patent No. : 10/039,201  
Filed/Issued : January 4, 2002  
Title/Mark : BEVELED WRITING POLE OF A PERPENDICULAR WRITING ELEMENT

1. Supplemental Information Disclosure Statement



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